

REMARKS

The above-identified application is United States application serial number 09/838,972 filed on April 20, 2001. Claims 1-31 are pending in the application. Claims 1-31 are rejected. Claims 1-3, 5-13, 19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nolan (US Patent 5,754,873). Claims 4, and 14-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nolan in view of Anderson et al (U.S. Patent No. 6,177,956). Claims 21-31 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Claim Objections

Regarding the Examiners objection to Claim 3 under 37 CFR 1.75(c), the applicants have restored the wording of Claim 3 to that of the original filing. The applicants regret that the wording of Claim 2 was inadvertently substituted at some point in the prosecution.

Rejection of Claims under 35 U.S.C. §112

Regarding the Examiners objection to the term "interactively" in Claims 21-31, although the applicants believe one of ordinary skill in the art would understand the term and its context, particularly in light of the discussion of interactive user actions described in detail in paragraphs [0023] and [0024], the applicants have removed the term from all claims.

With regard to the term "... to other images" in claim 21, the applicants believe one of ordinary skill in the art would readily understand the term to broadly refer to *any other images in general that may be displayed*, particularly in light of the discussion in paragraphs [0005] and [0006] in which a "user ranks photographic images," for example "based on criteria such as subjective value to the user," although other criteria may be used.

In other cases, the applicants have amended the claims to clarify antecedent basis as directed by the Examiner.

Rejection of Claims Under 35 U.S.C. §102(b)

Regarding the rejection of Claims 1-3, 5-13, 19, and 20 under 35 U.S.C. §102(b) as being anticipated by Nolan (US Patent 5,754,873), the applicant respectfully traverses the rejection of all claims.

The Examiner states "Nolan teaches displaying an image to the user; receiving information from the user for said image, said information comprising ranking information (display size); and sizing said image (text size) based on said ranking information." The Examiner bases these arguments on Nolan's column 2, lines 25-67 and column 3, lines 1-25, and figures 2 and 3a-c.

The applicants request the Examiner to kindly re-read the cited text. Nothing in Nolan's discussion discloses user entry of ranking information. Column 2, lines 25-27, states, "user enters a preferred display size." Size relates to size – a cardinal value, it has nothing to do with rating – an ordered or ordinal reference. Similarly in column 2, lines 34-35, reads, "a preferred display size is input to the computer system by a user." Also in column 3, lines 10-11, "the user need only enter a preferred display size." Nolan discloses other user entries that similarly are irrelevant to ranking. Column 2, line 46, states, "user selects the selected section of text," and in line 48-49, "user can then provide a scaling command."

Applicants would like to restate definitions supplied in the response to the Office Action dated 5-8-2003 with emphasis. In the present application, the aspect of ranking relates to relative standing or position of images in a system. In the present context, pertinent definitions for the word "rank" or "ranking" can be found in many standard dictionaries. For example, Dictionary.com (www.dictionary.com) defines rank as "A relative position or degree of value in a graded group." Similarly, Merriam-Webster Online dictionary (www.m-w.com/cgi-bin/dictionary) defines pertinent noun term of rank as "Relative standing or position and a grade of official standing in a hierarchy." Merriam-Webster defines a verb term of rank as "To determine the relative position of (rate)." American Heritage Dictionary of the English Language, Fourth Edition (www.bartlesby.com) pertinently defines the noun of rank as: "A relative position in a society;" and "A relative position or degree of value in a graded group." The verb term for rank is defined as "to give a particular order or position to; classify" and "To outrank or take

precedence over. " Common to all pertinent definitions of "rank" or "ranking information" is the aspect of relative rating or classification within a hierarchy.

Nolan's discussion from column 2, line 24, to column 3, line 25, explicitly, but also implicitly and inherently, discloses user entry of a preferred display size that is an absolute size and has nothing whatsoever to do with relational or ranking information. Accordingly, Nolan unambiguously discloses that the user enters an absolute size and not a ranking of image data as claimed by the applicants. Nolan even more unambiguously defines the user input as absolute size information rather than ranking information in the abstract, "A preferred absolute text height is input to the computer system by a user and is stored."

The Examiner relies on Figures 2 and 3A-3C, as support for entry of ranking information. These figures show nothing more than "a text section . . . displayed at a preferred size." Nolan's text describing Figures 2 and 3A-3C fully supports the applicants' interpretation that Nolan merely discloses user entry of absolute size information rather than "ranking information". Column 6, lines 9-10, relates, "user preferably picks a "zoom scaling preference" option." Column 6, lines 17-27:

"A scaling prompt 39 informs the user that a preferred displayed text size is to be entered. A user can enter a number (or other indication of magnitude in other embodiments) in entry field 40 indicative of the preferred size using, for example, keyboard 34. This number is the magnitude of the preferred size as defined by measurement units 41. . . [These] units are in inches; in alternate embodiments, different measurement units can be used, or the user may be allowed to change the preferred measurement units to centimeters, points, etc."

Nolan's discussion unambiguously describes user entry of absolute size information and has nothing to do with "ranking information". Description of units of measurement is conclusive indicia of a description of absolute size and not relational ranking.

In Figures 3A-3C, the Examiner appears to confuse Nolan's presence of multiple fonts with some type of ranking concept. The different font sizes are irrelevant to "ranking". The information supplied by the user is "preferred absolute text height" information, as described in the abstract. The information is not used to size different images according to rank as described and claimed by the applicants, but rather Nolan describes in column 9,

lines 1-4, "text section 46 has been increased in size *to the preferred size (0.22 inches in this example)* after the user has selected the zoom scaling control."

Applicants describe and claim a system in which each of different images are ranked by the user and sized according to the relative ranking. In Nolan, the user enters a preferred display size for a particular text image and other image sizes are scaled according to the one entered absolute size, as in column 9, lines 4-5, "Text sections 44 and 48 *have also been increased in size by the same scaling factor.*"

The applicants traverse the rejection of claims 2 and 3 because Nolan does not disclose "generating an album page" and "printing an album page", respectively. In paragraph 4, applicants refer to "software packages, [in which] a user can easily select and place photographic images into pre-made album page templates, then save the completed album page and/or print it." Nolan makes no reference to an "album page". The Examiner refers to Nolan's Figures 2, 3A-C which merely show computer display screens and have nothing to do with creating pictorial or photographic album pages, whether ultimately displayed on a screen, printed, or communicated via network.

The applicants traverse the rejection of claims 5-13 because Nolan describes nothing relevant to "ranking information" and thus cannot teach storing of ranking information.

The applicants further traverse the rejection of claim 6 because Nolan does not teach "repeating said displaying and said receiving for a plurality of images, before said sizing." The applicants claim receiving ranking information for each of the plurality of images. Nolan only describes receiving sizing information in association with one defined image. other images are scaled in accordance with the sizing of the one image.

The applicants further traverse the rejection of claims 7 and 8 because Nolan does not teach "sizing to zero all images associated with ranking information having a value less than a particular value." The Examiner refers to column 10, lines 15-18, which have nothing whatsoever to do with "sizing" but only relate to "deleting text" using an editor. The applicants would like the Examiner to point out how "deleting text" relates to "sizing to zero" and further explain how this operation takes place on the basis of the entered "display size" information. Regarding the Examiner's response to arguments, the end result of the "sizing to zero" operation and a "deleting" operation are not the same. In the sizing to zero operation, the image remains intact in storage without change and is merely omitted from

inclusion on an album page. In Nolan's deleting operation, text is simply eliminated from storage, no text image data remains in the system.

Rejection of Claims Under 35 U.S.C. §103(a)

Regarding the rejection of Claims 4, and 14-18 under 35 U.S.C. §102(b) as being unpatentable over Nolan in view of Anderson et al, the applicant respectfully traverses the rejection of all claims for many reasons. First, the references cited by the Examiner, when combined, fail to disclose the claimed invention. Second, no suggestion or modification of the references is given to modify or combine the references to produce the claimed invention (MPEP 2143.01). Third, the references, as combined by the Examiner, fail to teach or suggest all claim limitations (MPEP 2143.03).

The combined references continue to lack the aspect of user entry and receipt of "ranking information". The Examiner admits that Anderson's contribution is merely a teaching of a "photographic image" for the text image described in Nolan. In such a hypothetical combined system, the user enters and the system receives a "preferred display size", not a ranking, which would be associated with a particular photographic image. A combined hypothetical Nolan-Anderson system would display one or more photographic images *each scaled according to the entered "preferred display size"*. In contrast, the applicants disclose and claim a system in which each of the images is ranked individually and each is sized according to the entered ranking so that *relative sizes* of the different images can be changed using different rankings.

"Although a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." MPEP 2143.01, 916 F.2d at 682, 16 USPQ2d at 1432. The Nolan and Anderson references are mutually irrelevant to one another, the Nolan reference teaching a method and system for scaling text image data, and the Anderson reference teaching a method and system for compressing photographic image data (not image size). Each reference performs a function that is mutually unrelated and furthermore unrelated to the functions of the applicants' claimed system. Anderson does not give any motivation to scale displayed images as described in Anderson or to modify in any manner the display size. Instead Anderson only teaches a system for manipulating the encoding of an image.

The combined references fail to disclose the claimed aspect of receipt of "ranking information" so that Claim 4 is allowable on the same basis as claim 1, upon which claim 4 depends.

Claim 14 is allowable because the cited references fail to disclose "receiving ranking information" or "generating . . . album page."

Claims 15-18 are allowable because Nolan and Anderson fail to disclose "ranking control" or "select[ion of] a ranking."

Examiner's Response to Arguments

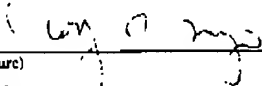
The Examiner reiterates arguments made in the record dated 07/23/2003 in which is made a citation to a dictionary meaning of "ranking information". The applicants note that the Examiner's definitional and logical usage of the term "ranking" has been extended to a similar treatment of the terms "ordinal" and "cardinal", which the applicants intended to introduce clarity into what is clearly described and claimed in the original application. The Examiner again refers to the text in column 2, line 25 to column 3, line 25 and Figures 2 and 3A-3C for support for a teaching of "ranking information". The Examiner states, "ranking information taught through Nolan is on relative terms and the hierarchy of information is clearly taught in the above citations and column 7, lines 1-8 as well, which very much fall under the category of 'ordinal numbers'". The applicants respectfully request the Examiner to point out a single instance in the cited text from column 2, line 24, to column 3, line 25, or elsewhere in Nolan, in which ranking information is received from a user that ranks an image relative to others of a plurality of images.

The Examiner refers to column 7, lines 1-8, in which three text sections have different sizes. That the sections have different sizes is irrelevant. The applicants respectfully request the Examiner find particular text in Nolan in which any of the three images is ranked in comparison to the other images. Nolan teaches that a user selects one of the images and selects an absolute display size for displaying the selected text. The other text images in Nolan are scaled identically with the scaling of the selected image. *There is no ranking that would cause the different images to be sized differently relative to one another.*


CONCLUSION

In view of the amendments and remarks set forth herein, the application, including all remaining Claims 1-31, is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned at (949) 251-0250.

I hereby certify that this correspondence is being facsimile transmitted to the USPTO. Control Number at (703) 872-9306 on the date shown below:


(Signature)
Ken J. Koestner
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March 12, 2004
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Respectfully submitted,


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